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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/673,239	09/30/2003	Masashi Morioka	243403US8	5391
22850 7590 11/04/2009 OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER JOHNS, CHRISTOPHER C				
ART UNIT		PAPER NUMBER		
3621				
NOTIFICATION DATE		DELIVERY MODE		
11/04/2009		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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**Advisory Action
Before the Filing of an Appeal Brief**

Application No. 10/673,239	Applicant(s) MORIOKA ET AL.
Examiner Christopher C. Johns	Art Unit 3621

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 17 September 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: _____.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____.

/Calvin L Hewitt II/
Supervisory Patent Examiner, Art Unit 3685

Christopher C Johns
Examiner
Art Unit: 3621

Continuation of 11, does NOT place the application in condition for allowance because: Applicants' arguments are unconvincing.

Before addressing the art (Davis et al; United States Patent 6,105,008), the Examiner notes a number of issues in Applicants' arguments.

Firstly, Applicants appear to have misread/misunderstood the Examiner's rejection and subsequent Interpretation section. Pages 4 and 5 of Applicants' response asserts that the "Office Action asserts that that conditional feature...is somehow optional" (page 4, ¶1), then cites the MPEP noting that while optional language may be omitted (page 4, lines 7-9), conditional language may not be omitted.

Without responding to this particular line of argumentation, the Examiner notes that he did NOT call Applicants' language "conditional"; in fact, it was explicitly addressed as "optional". See Paper Number 20090714, paragraphs 22-24, where the Examiner notes that "based on the determination..." step is "an OPTIONAL step in the claimed method (paragraph 22). As there is a determination, which by definition requires that a determination be made about some evaluation (i.e. "is X larger than Y?"), the entire step's dependence upon "based on the determination" renders it optional, because its very operation depends upon a specific determination being made.

The Examiner, in paragraphs 22-24 (same Paper Number), further notes that the generation of "an authentication and payment message that is sent to the authentication and payment server" is "an OPTIONAL step because the...sending is not actually recited in a positive manner". Were a system to never send an "authentication and payment message", the system could still be said to "provide the requested service BEFORE generating an authentication and payment message". A corollary: "before going to the baseball game, John has to go to the supermarket." If he never makes it to the baseball game, but does end up going to the supermarket, he has still satisfied the concept of going to the supermarket before ever going to a baseball game.

As Applicants have apparently acquiesced to the contention that "language that suggests or makes optional but does not require steps to be performed...does not limit the scope of a claim or claim limitation" (as they have underlined it, page 4, lines 15+), and as the language that the Examiner focused on was "optional" language, the interpretation of the claims stands. For further reading, Applicants are directed to Appeal 2008-1449 (decided 9 September 2008), pages 6-7.

Secondly, Applicants appear to be citing previous versions of the claims - pages 2 and 3 assert that Davis does not teach the limitations in independent claim 15, namely "providing by the service providing device, in a case the amount of payment is equal to or smaller than the reference amount...". This language, as of the amended claims of 13 April 2009, was CANCELLED from that claim (and like language was cancelled from independent claim 19); as such, Applicants' argumentation surrounding this language is puzzling. Ergo, the arguments that Applicants have made do not actually apply to the present claims.

Even ignoring the optional language issue, and applying as much as possible of Applicants' arguments to the current claims, the Examiner still finds that Davis in view of Official notice teaches the claim language. Davis teaches providing "the requested service to the terminal before the service providing device generates an authentication and payment message" (claim 15, similarly in claim 19) in a number of ways.

Firstly, as Davis does teach providing an authentication and payment message, it would have been obvious to one of ordinary skill in the art at the time of the invention to reorder the steps in which confirmations are sent. For example, a person having even low skill in the art has been required, at one point in time, to wait at a cash register while a credit card transaction processes. Cashiers are known to provide service to the customer even though the credit card system has not finished processing, because it allows for a faster system of processing customers. In the absence of any new or unexpected results, the changing of method steps is prima facie obvious. See MPEP §2144 IV C.

Secondly, were the system in Davis used twice (call them runs A and B), the service provided to the user in A would arrive at least some time before any generated message in B. Therefore, as Applicants' claim language is broad enough to encompass a situation involving multiple runs of the method in Davis, then Davis reads on the claim language and renders it unpatentable.

As the claim language is written in an optional sense and may be omitted (according to the MPEP and to Applicants, remarks, page 4, ¶2), Applicants' arguments are directed towards a non-claimed version of the claims, and as Davis in view of Official Notice teaches the claim language, the final rejection stands.